

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Lynn Ann Casey)	Group Art Unit: 3629
)	
Application No.: 10/686,608)	Examiner: Gabrielle A. McCormick
)	
Filed: October 17, 2003)	
)	
For: BORDER MANAGEMENT)	Confirmation No.: 8949
SOLUTION)	

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this brief reply to the Examiner's Answer mailed November 27, 2009. The time period for filing a reply to the Examiner's Answer is two months from the date of the Answer. Accordingly, this brief is timely filed on or before January 27, 2010.

For the reasons presented in the Appeal Brief filed on October 21, 2009 ("Appeal Brief"), and for the reasons presented in this brief, Appellant kindly requests the Board to reverse all of the outstanding claim rejections, so that pending claims 13, 20, 59-62, and 64-74 may be allowed without further delay.

Remarks begin on page 2 of this paper.

REMARKS

In addition to the arguments set forth in Appellant's Appeal Brief, Appellant provides the following remarks regarding the Examiner's Answer mailed November 27, 2009.

I. ARGUMENT

A. The Rejection Of Claims 59, 64, And 71 Under 35 U.S.C. § 112, First Paragraph, Should Be Reversed Because The Specification And Figures Comply With The Written Description Requirement.

Claims 59, 64, and 71 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement¹ and for allegedly not enabling one of ordinary skill in the art to make or use the invention. Claim 64 recites "applying neural networks, decision tree analysis, data recognition techniques, and rules-based algorithms to synthesize information, identify patterns, analyze historical information, and develop risk scores." Claims 59 and 71, although different in scope, recite similar elements.

In the Response to Argument section of the Examiner's Answer, the Examiner asserts:

[T]he specification provides no details as to which data is analyzed by which technique to identify patterns and develop risk scores. One [of] ordinary skill in the art would require the identification of variables and an algorithm in order to

¹ While the Final Office Action of May 21, 2009, (hereinafter "Office Action") rejected claims 59, 64, and 71 under 35 U.S.C. § 112, first paragraph, its discussion of the rejection only encompassed the alleged failure to comply with the enablement requirement. The only discussion of the claims' alleged failure to comply with the written description requirement was presented on pages 2 and 3 of the Office Action and only related to the now-withdrawn rejection for allegedly failing to adequately disclose "the capabilities of the computer-readable medium encoding instructions as claimed." Since the current written description rejection was not presented before the Examiner's Answer, Appellant treats the rejection of claims 59, 64, and 71 under 35 U.S.C. § 112, first paragraph, for alleged failure to comply with the written description requirement as a new rejection.

develop a risk score, however, none is provided by the specification. Further, no direction is provided as to what information (from the numerous sources) is synthesized or analyzed.

Answer at 15.

The eight edition of the Manual of Patent Examining Procedure (hereinafter “M.P.E.P.”) provides that the requirements for a written description is satisfied only when “a patent specification . . . describe[s] the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. 2163(I) (quoting *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116). The sufficiency of support in an application is judged by “whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” M.P.E.P. 2163.02 (quoting *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))).

In the Examiner’s Answer, the Examiner suggests that the persons of ordinary skill in the art are the “enforcement officials [that] perform the synthesis, analysis, and scoring.” Answer at 4 (citing paragraph [00084] of the specification as support). However, paragraph [00084] actually states, “The data warehousing solutions allow enforcement officials to synthesize information, identify patterns, analyze historical information, develop risk scores, and form intelligence.” Thus paragraph [00084] identifies enforcement officials as the **users**, not as the developers, of the described integrated border management systems and methods.

While enforcement officials may “synthesize information, identify patterns, analyze historical information, develop risk scores, and form intelligence,” paragraph [00084] of the specification clearly indicates that they would only do so using the disclosed systems and methods. Nothing in the specification suggests that enforcement officials would be skilled in the art of “implementing a border management application architecture” as recited in claim 59, “implementing an integrated border management system for managing individual and trade border transactions” as recited in claim 64, or “implementing a border management application architecture” as recited in claim 71. On the contrary, the specification indicates that the person of ordinary skill in the art is a developer of border management applications or systems: it states that the “[t]he present invention provides a border management business **architecture defining the structure for developing a border management solution** in terms of its capabilities and the interrelationships of those capabilities.” Specification at paragraph [00009], emphasis added. The only reasonable conclusion is that the person of ordinary skill in the art is a developer of border management applications or systems.

Moreover, the specification clearly discloses, “Data mining includes such applications as rules-based analysis, neural networks, decision tree analysis, and other data recognition techniques.” Specification at paragraph [00084]. A developer of border management applications or systems, like the inventor, would know of techniques such as “neural networks, decision tree analysis, data recognition techniques, and rules-based algorithms to synthesize information, identify patterns, analyze historical information, and develop risk scores,” as recited for example in claim 64. Therefore, a developer of border management applications or systems, like the

inventors, would know which data to analyze by which technique to identify patterns and develop risk scores. A developer, like the inventors, would also know which variables and which algorithm to identify in order to develop a risk score. Further, a developer, like the inventors, would know which information from which sources to synthesize and analyze, and would develop the applications, systems and methods accordingly.

When the specification is properly read with the person of ordinary skill in the art as a developer of border management applications and systems, the specification at paragraph [00084] reasonably conveys to such developers that the inventors had possession at that time of the filing of the application of the subject matter recited in claims 59, 64, and 71.

Therefore, Appellant's specification and figures comply with the written description of 35 U.S.C. § 112, first paragraph; and the rejection of claims 59, 64, and 71 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement should be reversed.

B. The Rejection Of Claims 65-69 Under 35 U.S.C. § 112, First Paragraph, Should Also Be Reversed Because The Specification And Figures Provide A Sufficient And Enabling Disclosure.

Claims 65-69 depend from claim 64. The Examiner rejected claims 65-69 69 under 35 U.S.C. § 112, first paragraph, solely because of their dependency from claim 64. See Answer at 4. There is no suggestion that the limitations recited directly in claims 65-69 lack the required written description or enablement of 35 U.S.C. § 112, first paragraph. Accordingly, the rejection of claims 65-69 under 35 U.S.C. § 112, first paragraph, are based solely on the recitations of claim 64, and Appellants will treat the

further recitations of claims 65-69 as complying with the written description and enablement requirements.

Because, in the Appeal Brief, Appellant has shown that the specification and figures provide an enabling disclosure for claim 64, and, because in this Reply to the Examiner's Answer, Appellant has shown that the specification and figures provide a sufficient disclosure for claim 64, by extension, Appellant has shown the same for claims 65-69. Therefore, the rejection of claims 65-69 under 35 U.S.C. § 112, first paragraph, should also be reversed.

C. The Rejection Of Claims 13, 20, 60-61, 70, And 72-73 Under 35 U.S.C. § 103(A) Should Be Reversed Because The Types Of Data And Applications Recited Are Functional.

Claims 13, 20, 60-61, 70, and 72-73 were rejected for allegedly being obvious under 35 U.S.C. § 103(a). Claim 13 is directed to a computer-based system for implementing a border management application architecture. Among other elements, the system of claim 13 recites "providing an **enforcement database** storing case data and individual data; [and] . . . **intelligence applications** used to **transform the border management data into intelligence** using the **shared border management data** and the **case data** and the **individual data stored in the enforcement database**." See Claim 13 (Emphasis added). Additionally, claims 20, 60, and 61 depend from claim 13, and therefore recite the same limitations. Independent claim 70, although different in scope from claim 13, and claims 72 and 73, depend directly or indirectly from claim 70, recite elements similar to those recited in claim 13.

In the Examiner's Answer, the Examiner maintained her rejection, asserting, "The Examiner views the claimed specified types of data and applications as non-functional."

Answer at 15. Appellant continues to disagree with the mis-characterization by the Examiner of the types of data and applications recited in claim 13 as non-functional.

In the Appeal Brief, Appellant argued that the names of the databases, core applications, and data identify their functionality. See Appeal Brief at 35. Because the types of data and applications recited in claims 13, 20, 60-61, 70, and 72-73 are functional, they distinguish the claims from the prior art in terms of patentability. In the Examiner's Answer, the Examiner asserts, "It is obvious to name applications, databases and data, however, the names themselves do not impart functionality."

Answer at 15. Without conceding the correctness of the Examiner's assertion, the names of the types of data and applications as recited in claims 13, 20, 60-61, 70, and 72-73 do impart functionality, and therefore, do distinguish the claims from the cited references. Examples of the types of data and applications with names that impart functionality, such as the core applications, are described in the Appeal Brief at pages 35-36 and therefore will not be repeated here.

In the Appeal Brief, Appellant quoted M.P.E.P. 2106.01: "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." See Appeal Brief at 36. In the Examiner's Answer, the Examiner rightly indicates that Appellant's recitation of M.P.E.P. 2106.01 at page 36 of the Appeal Brief "refers to **functional** descriptive material recorded on computer-readable medium." Answer at 15, emphasis in original. Appellant asserts that the quotation of M.P.E.P.

2106.01 continues to be proper, because the types of data and applications recited in claim 13 are “**functional**” descriptive material recorded on computer-readable medium.”

In view of the functionality of the recited types of data and applications, and in view of M.P.E.P. 2106.01, the use of technology permits the function of the types of data and applications recited in claims 13, 20, 60-61, 70, and 72-73, recorded on computer-readable medium, to be realized. Because the functionally descriptive types of data and applications recited in claims 13, 20, 60-61, 70, and 72-73 are not disclosed in the cited references, the asserted combination of the cited references cannot result in the recited features. For at least these reasons, a *prima facie* case of obviousness of claims 13, 20, 60-61, 70, and 72-73 has not been established and, therefore, the rejections of the claims under 35 U.S.C. § 103 as being obvious over *Wong* in view of *Coalition* are improper.

D. The Rejection Of Claims 62 And 74 Under 35 U.S.C. § 103(A) Should Be Reversed Because The References Do Not Disclose “The Shared Security And Integration Open Architecture Monitoring Access To The Core Applications.”

Claims 62 and 74 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,115,690 to Wong (“*Wong*”) in view of Coalition for Secure and Trade-Efficient Borders, Rethinking our Borders: A Plan for Action (“*Coalition*”). Claims 62 and 74 both recite “the instructions further include providing a shared security and integration open architecture between the customer channel interface and the set of core applications, the shared security and integration open architecture monitoring access to the core applications.” In the Examiner’s Answer, the Examiner contends that “*Wong* also discloses the use of a firewall that provides security

for internal data and allows limited access by customers Thus disclosing the ability to monitor and secure access via a firewall to a data source.” Answer at 8.

Even assuming the accuracy of the Examiner’s characterization of *Wong*, which Appellant does not concede, *Wong*’s teaching of “a data source” does not constitute the recited “core applications,” as required by the rejected claims. The conclusion of obviousness asserted by the Examiner’s Answer can only be reached by a mischaracterization of *Wong* and an application of impermissible hindsight, after having the benefit of Appellant’s specification.

E. The Rejection Of Claims 68 And 69 Under 35 U.S.C. § 103(A) Should Be Reversed Because The References Do Not Teach Or Suggest “Storing A Record Of The Denial [Of Entry] In The . . . Database.”

Claims 68 and 69 were rejected for allegedly being obvious under 35 U.S.C. § 103(a). Claims 68 and 69, which both depend from claim 64, both recite “storing a record of the denial [of entry] in the border management knowledge database.” The Final Office Action rejects dependent claims 68 and 69 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Coalition* in view of *Wong* in view of U.S. Patent Publication No. 2003/0115133 to Bian (“*Bian*”) in view of Houston Chronicle, *American Responds / Terrorist Watch List no Match for Pair / Hijacking Suspect Eluded All Controls* (“*Gugliotta*”). Office Action at 13.

In the discussion of the rejection in the Examiner’s Answer, the Examiner contends that *Coalition* discloses a “comprehensive computerized database to screen visa applicants and applicants for admission to Canada . . . , thus disclosing the denial of entry as a result of the screening process.” Answer at 17. The Examiner continues that “it is obvious that the screening process, when denying entry to an applicant would

at least lack the date of entry, therefore implicitly recording the denial.” Answer at 17. The Examiner has mis-characterized *Coalition*, because there might be reasons other than denial of entry to an application why a record of a screening would lack a date of entry. For example, a border guard might mistakenly omit the date from the record. Therefore, a “record of the denial of entry” cannot be inferred even from an undisclosed missing date of entry in a screening record in the *Coalition* database.

Appellant submits that *Coalition*’s teaching of a “comprehensive computerized database” and “screening process” does not constitute “**storing a record of the denial** [of entry] in the border management knowledge database” (emphasis added), as required by the rejected claims. The conclusion of obviousness asserted by the Examiner’s Answer can only be reached by a mischaracterization of *Coalition* and an application of impermissible hindsight, after having the benefit of Appellant’s specification.

II. CONCLUSION

Because the specification and figures provide a sufficient and enabling disclosure for the rejected claims, and because the references cited by the Examiner fail to render the claimed subject matter obvious under 35 U.S.C. § 103(a), the Examiner’s rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a) should be reversed.

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 27, 2010

By: 

Maura K. Moran
Reg. No. 31,859
(617) 452-1657